

REMARKS

The Advisory Action mailed on November 4, 2008, has been received and its contents carefully considered. It is respectfully submitted that this Amendment should be entered after final rejection as a Request for Continued Examination is filed herewith under 37 CFR §1.114. Additionally attached to this Response is a Petition for a Three-Month Extension of Time, extending the period for response to January 1, 2009.

Claims 1, 5-10, 11-15, 17-22 are now pending in the application. Claims 1, 5-9, 10-14, 20 and 22 have been amended. Claims 2-4, 16 and 23-24 have been cancelled. Support for the foregoing amendments may be found throughout the written description, drawings and claims, as originally filed.

Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Rejections for Double Patenting

Claims 1, 4, 5, 9-11, 14, 19, 21, 23 and 24 were rejected for obviousness double patenting over claims 7, 20-26 and 28-30 of co-pending application 11/515,761 (Our Docket No.: TOP 322C1). This rejection is respectfully traversed by the Terminal Disclaimer filed with the Amendment filed on October 1, 2008 but not entered.

Objections

The specification was objected to for new matter and has been amended as appropriate.

It is therefore respectfully requested that the objection be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1, 7-10, 12-14, 19 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kawa et al. (JP 2002-297309). These rejections are respectfully traversed, particularly in view of the foregoing amendments to claims 1 and 10.

Independent Claims 1 and 10, as amended, recites, among other things, a main portion including a housing, wherein the housing has a first surface and a second surface, *a receiving portion formed in the second surface and not exposed to the first surface, and a thickness of the housing that the receiving portion forms therein is thinner than that of the housing that the receiving portion does not form therein.* See, e.g., Specification at paragraph [0032],[0036] and Figures 2d and 2e.

When evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188- 89, 209 USPQ at 9). Consequently, "a receiving portion formed in the second surface and not exposed to the first surface, and a thickness of the housing that the receiving portion forms therein is

thinner than that of the housing that the receiving portion does not form therein", must be considered in the obviousness analysis.

The cited reference, however, does not teach or suggest the claimed invention.

The Examiner asserts that paragraph [0023] of Kawa discloses the above features. However, according to paragraph [0023], Kawa teaches that the surface layer of the main part 2 and the surface layer of the trackpad 53 are unified into the surface layer 54, and the trackpad 53 and the controller 45 are attached to the undersurface of the surface layer 54 as shown in the figure 3b. However, Kawa does not teach that a receiving portion should be formed in the undersurface of the surface layer 54 and a thickness of the surface layer 54 that the receiving portion forms therein is thinner than that of the surface layer 54 that the receiving portion does not form therein.

Although the examiner says that one of ordinary skill can make the thickness difference, Kawa at best teaches that if the trackpad is an electric capacity-type trackpad, it is possible to operate the trackpad even if the surface layer 54 is thick, and if the trackpad is a pressure-sensitive-type trackpad, it is good to make a thin surface layer 54. See, e.g., Specification at paragraph [0025]. In other words, Kawa only teaches what thickness of surface layer 54 may be used to cooperate with what type of trackpad. Therefore, Kawa does not teach a thickness of the surface layer 54 that the receiving portion forms therein is thinner than that of the surface layer 54 that the receiving portion does not form therein.

Moreover, the claimed invention further discloses that the housing's thickness at the receiving portion 111a is thinner than that at a region adjacent to the receiving

portion 111, thus, the touch pad 130 is more sensitive and performance thereof is enhanced. See, e.g., Specification at paragraph [0033]. In other words, the different thickness of the housing not only can improve the performance of the touch pad but also can make the housing has a standard thickness other than the region located the touch pad.

In view of the foregoing, Applicant respectfully submits that independent claims 1 and 10 are patentable over the cited references and in condition for allowance. Further, Applicant respectfully submits that dependent claims 7-9, 12-14, 19 and 21, which ultimately depend from claims 1 and 10, are likewise patentable and in condition for allowance. Withdrawal of the foregoing rejections under 35 U.S.C. § 103(a) is, therefore, respectfully requested.

Claims 5, 6, 11 and 15 were rejected under 35 U.S.C. §103(a) as obvious over the combination of *Kawa et al.* and *Keely, Jr. et al.* (US 2002/0063694 A1). This rejection is respectfully traversed.

Claims 5 and 6 depend from claim 1, and claims 11 and 15 depend from claim 10. As claims 1 and 10 are allowable, and as *Keely, Jr. et al.* fails to overcome the deficiencies of *Kawa et al.* with respect to claims 1 and 10, therefore claims 5, 6, 11 and 15 are also allowable.

Claim 17, 18, 20 and 22 were rejected under 35 U.S.C. §103(a) as obvious over the combination of *Kawa et al.* and *Gamer* (US 6,501,462 B1). This rejection is respectfully traversed.

Claims 17 and 20 depend from claim 1, and claims 18 and 22 depend from claim 10. As claims 1 and 10 are allowable, and as *Gamer* fails to overcome the deficiencies

of *Kawa et al.* with respect to claims 1 and 10, therefore claims 17, 18, 20 and 22 are also allowable.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

Respectfully submitted,

December 30, 2008
Date



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